

### **REMARKS**

Entry of this Amendment and reconsideration are respectfully requested in view of the amendments made to the claims and for the remarks made herein.

Claims 1-4, 9-16, 19-26, 29-31, and 36-47 are pending. Claims 1, 11, 15-16, 21, 25-26, 31, 38-39, 41 and 45 have been rejected. Claims 2-4, 9, 10, 12-14, 19-20, 22-24, 29-30, 36-37, 40, 42-44 and 46-47 were withdrawn from further consideration in Applicants' prior response. Claims 5-8, 17-18, 27-28 and 32-35 were cancelled in Applicants' prior response. Claims 1, 11, 15, 16, 21, 25, 26, 31, 38, 39, 41 and 45 remain for consideration in the instant application. Claims 1, 11, 21, 31, 38 and 39 have been amended. Support for the amendment can be found, for example, on page 5, lines 26-30. Accordingly, no new matter has been added.

#### **Rejection Under 35 U.S.C. § 101**

Claims 38-39, 41 and 45 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. The Office Action states that the language "computer readable medium" as recited by the claims is not described in the specification so that it is limited to tangible embodiments such as CDs or ROMs. See Office Action at page 2. The rejection is respectfully traversed.

The specification has been amended to provide literal support for the claim element "computer readable medium". Support for the amendment can be found, for example, in the originally filed claim 38, which constitutes part of the original disclosure. See, e.g., MPEP § 608.01(I).

According to MPEP § 706, "[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity." Since the Office has not identified which embodiment(s) disclosed in the specification is not a tangible medium, Applicants would be prejudiced if a final rejection is issued without having been informed of the basis in the disclosure for the interpretation given to claims 38-39, 41 and 45, and afforded an opportunity to address the

appropriateness of the rejection under 35 U.S.C. § 101 with pertinent evidence and/or arguments.

Moreover, the term “computer readable medium” should not be narrowly construed to encompass only the examples indicated in the Office Action. It is well understood by those skilled in the art to include, for example, any tangible medium that can store data which can be thereafter be read by a computer system, or that can produce a concrete, useful and tangible result, such as, through a computer system. Examples of “computer readable medium” include a floppy disk, a hard disk, a magnetic tape, any magnetic medium, CD-ROM, any other optical medium, a RAM, a PROM, an EPROM, a FLASH-EPROM, any other memory chip or cartridge, etc. See, e.g., U.S. Patent 6,014,706, col. 10, lines 4-9.

Furthermore, as used in the claims, “computer readable medium” falls within the definition of “functional descriptive material” as that term is used in the MPEP § 2106.01, because it imparts functionality (e.g., to obtain information, learn preferences, and/or generate a recommendation) when employed as a computer component. The MPEP states there that “[w]hen functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.” Therefore, the rejection in the Office Action appears to be contrary to the Office’s own established position.

Applicants believe that the reason for the rejection has been overcome and respectfully requests the rejection be withdrawn.

#### Rejection Under 35 U.S.C. § 112

Claims 38-39, 41 and 45 stand rejected under 35 USC § 112, second paragraph, as being indefinite. The Office Action recites that the claim elements “an article of manufacture” and “a computer readable medium” are not clearly described in the specification. See Office Action at pages 2 and 3. The rejection is respectfully traversed.

Applicants have amended the specification to provide literal support for “computer readable medium”. Support for the amendment can be found, for example, in

the originally filed claim 38, which constitutes part of the original disclosure. See, e.g., MPEP 608.01(l).

Claims 38-39, 41 and 45 as amended do not recite “an article of manufacture”. As explained above, the term “computer readable medium” is readily discernible by those skilled in the art to include, for example, any tangible medium that can store data which can be thereafter be read by a computer system. Various examples of “computer readable medium”, such as magnetic media, optical media such as optical disks, or other physical media such as punched tape, etc., are clearly taught in the art. See, for example, U.S. Patent 6,014,706, col. 10, lines 4-9. Therefore, the use of the “computer readable medium” is not indefinite within 35 U.S.C. 112, second paragraph. Applicants believe that the reason for the rejection has been overcome and respectfully requests the rejection be withdrawn.

#### First Rejection Under 35 U.S.C. § 103

Claims 1, 11, 21, 31, 38-39, 41 and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Application Publication No. US 2002/0052873 of Delgado et al. (“Delgado”) in view of U.S. Patent 6,975,910 to Brown et al. (“Brown”) and U.S. Patent 6,370,513 to Kolawa et al. (“Kolawa”). The reasons for the rejection are stated on pages 3-5 of the Office Action. The rejection is respectfully traversed.

Before discussing the distinctions between the claims and the cited references alleged by the Office to render the claims patentable under 35 U.S.C. 103, the Supreme Court case of *KSR International Co. v. Teleflex Inc. et al.* which was decided on April 30, 2007, should be considered. The Supreme Court in this case reversed the Court of Appeal for the Federal Circuit's application of the so called “teaching, suggestion, or motivation” (TSM) test, in favor of a broad inquiry based on the *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, and, in the words of the Court, on common sense.

The prohibition against using hindsight, however was maintained. The opinion stated, for example:

“A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. See *Graham*, 383 U.S., at 36 (warning against a “temptation to

read into the prior art the teachings of the invention in issue” and instructing courts to “ ‘guard against slipping into the use of hindsight’ ” (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F. 2d 406, 412 (CA6 1964))). Rigid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it.”

Considering now the rejected claims, and what is fairly taught by Delgado, Brown, and Kolawa, and using a common sense approach (but not hindsight) as called for by the Supreme Court in *KSR International Co. v. Teleflex Inc. et al.*, Applicants respectfully submit that none of the cited references, alone or in combination, teach or fairly suggest at least one element of the claims as described below in more detail. The Office Action states that the claimed feature of “determining preferences of said user under said one or more environmental characteristics” is disclosed in paragraph [0038] of Delgado. Applicants respectfully disagree. However, to expedite the examination of the present application, but without conceding the correctness of the Office’s rejection, independent claim 1 has been amended to recite a step or means of learning the preferences of the user for each item to be recommended while exposed to, or under, one or more observed environmental characteristics. Applicants respectfully maintain that the above-mentioned feature is not taught or suggested by the cited references.

According to Delgado at paragraph [0038], user-specified search criteria, such as vacation features that are most important to the user (e.g., activities), is inputted into a vacation recommender system to obtain a recommendation. A vacation to be recommended may be mapped in a domain space as having, among other features, a certain weather characteristics (e.g., great weather), and the user preference for a vacation with a certain weather condition may be similarly mapped in the domain space, possibly to allow the system to determine the vacation destination that closely matches the user’s preference. See Delgado, paragraph [0041]. As acknowledged in the Office, the weather conditions “observed” and mapped in the domain space are characteristics of vacation destinations. See Office Action at page 3, stating that “when recommending a vacation with nice weather condition, it is clear that the weather condition of such recommended vacation would have been obviously, if not implicitly, accessed via a weather server

system...” Therefore, even if Delgado involves observing environmental characteristics, it does not teach observing the environmental characteristics the user is exposed to, e.g., while specifying the vacation features that are most important to him or her, for the purpose of learning the user’s demonstrated preference(s) under those environmental conditions. Instead, Delgado only “observes” the environmental conditions of a vacation destination, which, unlike the claimed invention, is not the environmental condition the user is under when selecting a vacation. Therefore, the system or method of Delgado does not teach or suggest learning the user’s demonstrated preference under or while exposed to a given environmental condition. The missing feature of Delgado is also not taught or suggested by Brown or Kolawa.

Since Delgado, Brown and Kolawa do not teach or suggest learning preferences of the user for each item to be recommended while exposed to and under one or more observed environmental characteristics, as recited in the amended independent claim 1, (claims 11, 21 and 38-39 have similar elements), these claims cannot be rendered obvious by the cited references. The cited references also cannot render claim 31 obvious because they do not provide any suggestion or teaching regarding learning the preferences of the user for each item to be recommended while exposed to and under a characteristic of motion.

For at least the foregoing reasons, Applicants submit that the rejection has been overcome and respectfully requests withdrawal of the rejection and allowance of the independent claims.

With regard to the dependent claims, these claims ultimately depend from the independent claims, which has been shown not to be obvious, and, hence, allowable, over the cited references. Accordingly, the remaining dependent claims are also allowable by virtue of their dependence from an allowable base claim.

Second Rejection Under 35 U.S.C. § 103

Claims 1, 11, 15-16, 21, 25-26, 31, 38-39, 41 and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown in view of Kolawa and U.S. Patent 5,590,246 to Asgharzadeh et al. (“Asgharzadeh”). The reasons for the rejection are stated on pages 5-7 of the Office Action. The rejection is respectfully traversed.

The Office Action states that the claimed feature of “determining preferences of said user under said one or more environmental characteristics” is disclosed in col. 10, lines 41-48 of Brown. Applicants respectfully disagree. However, to expedite the examination of the present application, but without conceding the correctness of the Office’s rejection, independent claim 1 has been amended to recite a step or means of learning the preferences of the user for each item to be recommended while exposed to one or more observed environmental characteristics. Applicants respectfully maintain that the above-mentioned feature is not taught or suggested by the cited references.

Brown relates to a system and method for managing an electronic cookbook to meet the dietary needs of multiple diverse users (col. 1, lines 9-11). According to Brown, environmental exposure is preferably taken into consideration when filtering recipes database (col. 10, lines 42-48). While Brown may disclose recording each food item consumed by a user and the environmental exposure of a user over a period of time (col. 6, lines 34-35 and 61-63), and filtering recipes database based on environmental exposure (col. 10, lines 42-43), it does not teach or suggest, for example, learning from the recorded information the user’s demonstrated preference for a particular food item while exposed to or under an environmental condition and specifying such preference in, e.g., the user profile or dietary needs/health plan of the user. The example provided in col. 10, line 43-48 of Brown and referenced in the Office Action, illustrates making a recommendation (e.g., hot dish) based solely on environmental exposure of the user. No consideration is given to the user’s demonstrated preference for the food item when exposed to a similar environmental condition because such correlation is not determined or learned by the system or method of Brown. The missing feature of Brown is also not taught or suggested by Kolawa and or Asgharzadeh.

Since Brown, Kolawa and Asgharzadeh do not teach or suggest learning preferences of the user for each item to be recommended while exposed to and under one

or more observed environmental characteristics, as recited in the amended independent claim 1 (claims 11, 21 and 38-39 recite similar elements), these claims cannot be rendered obvious by the cited references. The cited references also cannot render claim 31 obvious because they do not provide any suggestion or teaching regarding learning the preferences of the user for each item to be recommended while exposed to and under a characteristic of motion. For at least the foregoing reasons, applicants submit that the rejection has been overcome and respectfully requests withdrawal of the rejection and allowance of the independent claims.

With regard to the dependent claims, these claims ultimately depend from the independent claims, which has been shown not to be obvious, and, hence, allowable, over the cited references. Accordingly, the remaining dependent claims are also allowable by virtue of their dependence from an allowable base claim.

Applicants have endeavored to make the foregoing response sufficiently complete to permit prompt, favorable action on the subject patent application. In the event that the Examiner believes, after consideration of this response, that the prosecution of the subject patent application would be expedited by an interview with an authorized representative of the Applicants; the Examiner is invited to contact Yan Glickberg at (914) 333-9618.

Applicants respectfully submit that by this Amendment, the application has been placed in condition for allowance and such action is respectfully requested.

Respectfully submitted,

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